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Mark Joseph Hamzy

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Section IV:
AMENDMENT UNDER 37 CFR §1.121
REMARKS

Request for Telephone Interview

Applicant's Agent, Robert H. Frantz, requests a telephone interview with the Examiner following receipt and review of the present reply and amendment in order to answer any questions or consider any suggestions the Examiner may have.

Examiner is requested to contact Mr. Frantz at 405-812-5613 to indicate a time and date of the Examiner's availability for the telephone interview.

Rejections under 35 U.S.C. §112

In the Office Action, the examiner has rejected claims 1, 9, 13, 20, and 24 under 35 U.S.C. §112, second paragraph, for being indefinite with respect to recitation of "such as" in the preamble of the claims.

Claims 13 and 24 have been canceled by the present amendment, and Claims 1, 9, and 20 have been amended to delete the phrase "such as" and to definitely recite elements, steps or limitations of our invention. Reconsideration of these rejections is requested.

Rejections under 35 U.S.C. §102(e)

In the Office Action, the examiner has rejected claims 1, 4 - 6, 8, 9, 12, 13, 16 - 20, 23, 24, and 27 - 30 under 35 U.S.C. §102(e) for lack of novelty as being anticipated by U.S. Patent Number 6,443,840 to Von Kohorn (hereinafter "Von Kohorn").

Claims 13, 16 - 19, 24, and 27 - 30 have been canceled by the present amendment.

With respect to the rejection of independent claims 1, 9, and 20 and based upon our understanding Von Kohorn's disclosure, we believe the following technical differences exist between the cited art:

- (1) Von Kohorn only briefly mentions that their TV broadcast can include video transmitted over the Internet (see Col. 138, lines 37 - 44), but is silent as to

transmitting other types of web objects such as GIF images, HTML, etc. Our invention is directed towards collecting the spontaneous reaction of a consumer to a web-based advertisement message including such web objects, not towards allowing a user to interact with a TV broadcast signal.

- (2) Von Kohorn very briefly mentions that their TV broadcast may be an advertisement (see Col. 34, lines 11 - 33), but is silent as to capturing the spontaneous reaction of the viewer (e.g. the natural reaction). Instead, Von Kohorn seems to be directed towards allowing a user to interact, reply to, or purposefully make input in response to an advertisement. To the contrary, our invention is directed towards automatically collecting data regarding the spontaneous consumer's reaction, at a certain delay from the time of presentation of the message to the consumer, and does not require the user to intentionally make an input (e.g. a choice selection). For example, Von Kohorn's abstract states that:

... At each of a plurality of remote receiving stations, one or more members of a remote audience has the opportunity to respond to a situation presented in the television program by entering a response on a keyboard. (Abstract, emphasis added)

By providing the viewer the "opportunity to respond", this implies that the user may decide not to respond, as well (e.g. foregoing the opportunity). And, clearly this opportunity to respond is taken by the user's entry of a response, thereby requiring activity by the user to collect the response.

We have amended our claims to include steps, elements or limitations that specify how our collection of the user's spontaneous response is recorded, automatically timed from the start of the display of the advertisement to a certain time (e.g. delay) after the ad is displayed, without requiring the user to intentionally or actively take any particular action.

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With respect to the rejections of Claims 4, 12, 15, and 23, Von Kohorn fails to teach recording of an audio response automatically without user action at a pre-determined time from the presentation of the advertisement, but instead provides the consumer an opportunity to respond if desired.

With respect to the rejections of Claim 5, Examiner has cited Kohorn's teaching at col. 38, lines 39 - 51 for "acceptable responses", col. 52, lines 49 - 50 for "unacceptable responses":

With reference to FIG. 8, the response unit 210 receives the designated response criteria signals and the scoring mode signals, the signals being stored in memory for evaluating answers of the members of the remote audience 216 (FIG. 6) in responding to tasks set forth in the studio 204. In order to facilitate explanation of the response unit 210, the memory which stores data of the designated response criteria and the scoring mode, is shown as three separate memories, namely, a program memory 330 which stores instructions for operation of the response unit 210, a response-criteria memory 332 which stores a set of data-defining acceptable or designated responses to be used as a reference against which audience response is to be judged, and a further scoring program memory 334 which stores coefficients or values of difficulty levels employed in the scoring of audience responses. A timing unit 336 is employed for interjecting a scoring factor based on the amount of time required or allowed to generate the response, and to apply zero credit in the situation wherein a member of the remote audience fails to respond within a predesignated time interval. The response unit 210 includes four decoders 338, 340, 342, and 344 which extract various portions of the digitized designated response criteria signal and scoring mode signal for application to individual ones of the memories 330 and 332, the timing unit 336 and the memory 334. The decoders 338 and 340 connect lines 348 and 346, carrying the scoring-mode and response-criteria signals, respectively, to the memories 330 and 332. The decoders 342 and 344 connect from line 348, carrying the scoring mode signal, respectively to the timing unit 336 and the memory 334. The decoder 344 may be coupled directly to the memory 334, or via an OR gate which will be described with reference to FIG. 23. To facilitate the present explanation of this embodiment of

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the invention, it is presumed that the decoder 344 is connected directly to the memory 334. (col. 38, line 39 *et seq*, emphasis added)

The method provides for penalizing a contestant for not answering or for unacceptably answering a question, irrespective of the difficulty level by deducting credits determined in accordance with the scoring mode from the accumulated credits of such viewer. The response criteria may be transmitted as an unobtrusive portion of the TV-signals, by optical means, over voice channels, or other means. The total number of credits earned by a viewer and a verification number or code provided on said record in accordance with instructional signals transmitted as fourth signals, may be phoned in by a contestant and the host announces a winner or winners near the end of the show. (col. 52, line 49 *et seq*, emphasis added)

And, Examiner has stated:

"where indifferent reactions are inherent with Von Kohorn since acceptable and unacceptable reactions are already determined and indifferent reactions is a reaction in between acceptable and unacceptable."

Pursuant to the previous argument, the first passage from Kohorn clearly indicates that a user must voluntarily make a response within a maximum amount of time, rather than automatically collecting a response at a predetermined time after the showing of the advertisement as we have claimed.

Applicant traverses this further interpretation of Kohorn's disclosure, and Examiner's statement that an indifferent response is a reaction between acceptable and unacceptable. In Von Kohorn's disclosure, "acceptable" and "unacceptable" are being used with reference to scoring the correctness of a user's voluntary response (e.g. right vs. wrong, satisfactory or falling within the bounds of allowable answers).

In our claim 5, however, we have not employed the term "acceptable" and "unacceptable", but rather have employed the terms "favorable" and "disfavorable" meaning the apparent spontaneous reaction to the advertisement was pleasing or unpleasing to the viewer,

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which is neither right or wrong nor bounded by any range of acceptance.

These definitions are well known in the art (*source: Dictionary.com, emphasis added*):

acceptable (adj.)

1. Worthy of being accepted.
2. Adequate to satisfy a need, requirement, or standard; satisfactory.

unacceptable (adj.)

Not acceptable; unsatisfactory.

favorable (adj.)

1. Advantageous; helpful: favorable winds.
2. Encouraging; propitious: a favorable diagnosis.
3. Manifesting approval; commendatory: a favorable report.
4. Winning approval; pleasing: a favorable impression.
5. Granting what has been desired or requested: a favorable reply.
6. Indulgent or partial: listened with a favorable ear.

disfavorable (adj.)

Unfavorable.

Please note that the definitions of acceptable and favorable do not overlap in any of their definitions, even when considering their synonyms and antonyms. For this reason, in addition to the foregoing reasons stated with respect to Claim 1, Applicant requests withdrawal of the rejection of Claim 5.

With respect to the rejection of Claims 6, 8, and 20, Von Kohorn fails to teach the limitations of the independent claims from which these depend, and thus the rejections of these claims should be withdrawn in view of the present amendment.

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In summary, with respect to the rejections under 35 U.S.C. §102(e) and for the foregoing reasons, the rejections should be withdrawn in view of the present amendment because:

1. The cited reference, Von Kohorn's patent, does not properly anticipate the claimed invention, as it fails to disclose all the claimed steps, elements or limitations. MPEP 2131 states:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM (*capitalization emphasis found
in original text*)

2. The cited reference, Von Kohorn's patent, does not properly anticipate the claimed invention, as it fails to disclose all the claimed steps, elements or limitations as set forth according to the applicant's terminology. Terminology and definitions of the cited reference(s) have been improperly employed to interpret the meaning and scope of the applicant's claims. MPEP 2173.01 states:

Claim Terminology. A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art.

Further, MPEP 608.01 states:

The claims should be construed in light of the specification.

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Rejections under 35 U.S.C. §103

In the Office Action, the Examiner has rejected Claims 2, 3, 7, 10, 11, 14, 15, 21, 22, 25 and 26 under 35 U.S.C. §103(a) as being unpatentable over Von Kohorn in further view of U.S. Patent 6,548,967 to Dowling (hereinafter "Dowling"). Claims 14, 15, 25 and 26 have been canceled by the present amendment.

To our best understanding of Dowling's disclosure, their "smart lighting devices" capture a subject person's responses without requiring the user's initiation of a response entry. However, Dowling's only mention of capturing a subject's response *to an advertisement* is with respect to response to a *physical* advertisement, such as a product display on a showroom floor (e.g. retail environment), but not timed to an advertisement shown on a client computer device as we have claimed:

In a retail or entertainment environment, such as a department store, park, resort, or casino, such data may also be useful to identify customer reactions to displays. For example, a smart lighting element in a display, or a smart lighting network in a retail environment, may collect information such as how long customers view a display on average, whether a display attracts people from distant parts of a store, or even capture or analyze features such as facial expressions, to gauge customer's interest in and reaction to a retail display, advertisement, or other display meant to attract attention. Such information may further be correlated with information such as sales data, e.g., collected at check-out lines, cash registers, or other inventory systems, to determine the overall effectiveness of retail displays and advertisements. By reviewing and analyzing such data, retailers and marketers can more accurately gauge what types of displays, what locations, and what combinations of items are preferred by customers, are engaging, and are most effective at inducing increased sales. Such information can also be used to distribute high-interest items throughout a store to achieve even traffic flows, or to increase customer exposure to new or obscure types of merchandise, or items that are typically bought on impulse. (Dowling Col. 10, lines 37 - 59, emphasis added)

Dowling is silent with respect to collecting the response of a viewer to an online advertisement as we have claimed. This is true especially in view of the fact that Dowling mentions use of their collection systems in an office environment, such as an environment having a personal computer (see Dowling's Figure 10), but is silent as to any coordination of the collection of subject's facial expressions or verbal responses to the timing of anything shown or presented on that computer:

FIG. 10 shows an office environment according to the invention. The office environment 1000, whether home or work, offers another venue for building automation systems. Lighting module subsystems 1010, shown mounted to two walls, provide capability for networking and sensors for detecting if people are in the office. Wireless and wired networks may use the lighting module subsystems 1010 as well, as input or output devices, nodes, or communication hubs. A system using lighting module subsystems 1010 within the office environment 1000 can detect pilferage and unwanted employee intrusions, as well as providing a communications conduit for the office resident. The lighting module subsystem 1010 may also support TCP/IP networking, and may provide for web browsing capability external to the office. The networked capabilities may thus simplify data collection and reporting capabilities in the office environment 1000, and simplify office networking, either by creating a network or supplementing an existing network. (Dowling's Col. 23, lines 33 - 50, emphasis added).

Dowling mentions detection of people in the vicinity, pilferage, and intrusions, as well as providing communications hubs and external web browsing, but no mention is made of coordinating the collection of the user's captured verbal or facial expressions at a certain delay relative to the presentation of anything on the computer in the vicinity.

Additionally, the proposed Von Kohorn - Dowling combination fails to teach the steps, elements and limitations as previously discussed with respect to the rejections of the independent claims from which these claims depend. For these reasons, Applicant requests withdrawal of the rejections of Claims 2, 3, 7, 10, 11, 21, and 22 because:

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3. The combination or modification of the references in the manner suggested by the examiner does not teach all the claimed elements, steps, or restrictions. MPEP §2143.03 states:

All Claim Limitations Must Be Taught or Suggested. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

4. Motivation or suggestion to make the examiner's combination or modification of the references is not found in the cited art. MPEP §2143.01 states:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Examiner has not established in the Office Action where in Von Kohorn or Dowling suggestion is made to make the combination as proposed, but has only stated it would have been obvious to make the combination. Suggestion or motivation must be present in the references, or no *prima facie* case of obviousness can be established.

Conclusion

Applicant requests entry of the amendment, reconsideration of the rejections, and allowance of all remaining claims as amended.

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